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09/867,629	05/31/2001	Yoshiyuki Asayama	209252US0	7671

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER //

NORDMEYER, PATRICIA L

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 05/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/867,629

Applicant(s)

ASAYAMA ET AL.

Examiner

Patricia L. Nordmeyer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Withdrawn Rejections

1. The 102 rejection of claims 3 – 6 and 10 – 16 as anticipated by Sandstrom et al. in Paper #6, Page 5, Paragraph #7 has been withdrawn due to Applicant's arguments in Paper #10.
2. The 102 rejection of claim 1 as anticipated by Sjöström in Paper #6, Pages 5 – 6, Paragraph #8 has been withdrawn due to Applicant's arguments in Paper #10.
3. The 103 rejection of claims 2 and 7 – 9 over Sjöström in view of Mukoyoshi et al. in Paper #6, Pages 6 – 7, Paragraph #10 has been withdrawn due to Applicant's arguments in Paper #10.

New Rejections

Claim Objections

4. Claim 7 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claim has not been further treated on the merits.
5. Claims 8 and 9 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

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Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is unclear. The claim is directed towards an article, however there are no structural limitations present in the claim language. The article is not clearly set forth in the claim. The invention needs to distinctly claimed in order to set forth the present invention in which the conditions describes.

Correction/clarification is required.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 2 and 15 rejected under 35 U.S.C. 103(a) as being unpatentable over Oguni et al. (USPN 5,698,627).

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Oguni et al. discloses a paperboard (Column 6, lines 35 – 42) made from mechanical pulp (Column 6, lines 62 – 63) that is tested for compressive strength using JIS P 8126 (Column 9, line 66 and Column 11, Table 3) and JIS P 8113 elongation at break test (Column 12, Table 4). However, Oguni et al. fails to disclose the exact values of each of the conditions of the mold base paper and a molded paper vessel formed by drawing.

One of ordinary skill in the art would have recognized the claimed paperboard would have the same tensile strength, elongation at break, critical compression stress and amount of compression deformation since Oguni et al. teaches the paperboard being made from mechanical pulp and put through the same JIS P 8126 and JIS P 8113 as the invention. Therefore, one of ordinary skill in the art would readily determine the optimum conditions depending on the desired end results in the absence of unexpected results.

Regarding the limitation of the a molded paper vessel formed by drawing in claim 15, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation of drawing is a method of production and therefore does not determine the patentability of the product itself. Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which

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reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

10. Claims 1, 2 and 10 – 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi et al. (USPN 4,230,525) in view of Sandstrom et al. (USPN 6,379,497).

Yamaguchi et al. discloses a paper (Column 1, line 49) made from mechanical pulp (Column 4, lines 4 – 6) that is tested for compressive strength using JIS P 8126 (Column 6, lines 44 – 47 and Column 7, Table 2) and JIS P 8113 elongation at break test (Column 5, line 66 and Column 6, Table 1 and Column 7, Table 2). However, Yamaguchi et al. fails to disclose the exact values of each of the conditions of the mold base paper, a synthetic resin layer on at least one surface thereof, a molded paper vessel formed by drawing, and a vessel that complies with the formula.

Sandstrom et al. teaches a multi-layer paperboard (Column 51, line 8) made from pulping processes such as mechanical pulping, thermomechanical pulping and chemi-thermomechanical pulping (Column 11, lines 5 – 10) with a synthetic resin is coated on both sides (Column 11, lines 54 – 57 and Column 12, lines 31 - 34) which may include a pigment selected from variety of materials including clay, talc, calcium carbonate (Column 18, lines 30 – 35) and kaolin

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(Column 18, line 6), where the resin is selected from the containing polyethylene, polypropylene, polyethylene terephthalate, methyl cellulose, carboxymethyl cellulose acetate copolymer (Column 12, lines 34 – 45) and polyvinyl alcohol (Column 18, lines 13 – 26), in a container which meets the limitations of the claimed formula (see Figures 16A – 25B) for the purpose of forming a paperboard material into containers where the paperboard does not lose any of its integrity, thereby allowing the container to hold hot and cold items longer.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the synthetic coating on container that means the limitations of the formula in Yamaguchi et al. in order to form a paperboard material into containers where the paperboard does not lose any of its integrity, thereby allowing the container to hold hot and cold items longer as taught by Sandstrom et al.

One of ordinary skill in the art would have recognized the claimed paperboard would have the same tensile strength, elongation at break, critical compression stress and amount of compression deformation since Yamaguchi et al. teaches the paperboard being made from mechanical pulp and put through the same JIS P 8126 and JIS P 8113 as the invention. Therefore, one of ordinary skill in the art would readily determine the optimum conditions depending on the desired end results in the absence of unexpected results.

Regarding the limitation of the a molded paper vessel formed by drawing in claim 15, the determination of patentability for a product-by-process claim is based on the product itself and

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not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation of drawing is a method of production and therefore does not determine the patentability of the product itself. Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

11. Claims 3 – 9 and 17 – 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Canary (USPN 5,204,173) in view of Mukoyoshi et al. (USPN 6,187,430) and further in view of Sandstrom et al.

Canary teaches a paperboard product (Column 3, line 35) have a density between 0.4 to 0.5 g/cm³ and another density between 0.8 to 0.95 g/cm³ (Column 4, lines 13 – 16). However, Canary fails to disclose for the molding base paper further comprising a crack preventing layer having an elongation at break of at least 5%, the crack preventing layer having an elongation of at least 6%, having a basis of weight of 50 to 150g/m², the paper being composed of mechanical

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pulp, the base paper having a basis weight of 100 to 500 g/cm³, a synthetic layer on at least once surface thereof, a vessel formed by drawing, the mechanical pulp being a thermomechanical pulp and a vessel that complies with the formula.

Mukoyoshi et al. teaches a mechanical pulp (Column 4, lines 28 – 29) in a sheet that has a coating of a polymer resin (Column 6, lines 30 – 33) with a basis weight of 2 to 100g/m² (Column 7, lines 27 – 30) for the purpose of giving the sheet the ability to absorb inks and give it good mechanical strength so it is not easily damaged. Since the coating is on the selected material, has the selected base weight and contains the selected resins (Column 5, lines 54 – 68), it is inherent that the coating has an elongation at break of at least 5 or 6%.

Sandstrom et al. teaches a multi-layer paperboard (Column 51, line 8) with an overall weight of the board is 100 to 520 g/cm³ (Column 5, lines 45 to 50) formed with pulping processes such as mechanical pulping, thermomechanical pulping and chemi-thermomechanical pulping (Column 11, lines 5 – 10) in a container which meets the limitations of the claimed formula (see Figures 16A – 25B) for the purpose of forming a paperboard material into containers where the paperboard does not lose any of its integrity, thereby allowing the container to hold hot and cold items longer.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the coating layer of a basis weight of 2 to 100g/m² and formed into a container from thermomechanical pulp in Canada in order to give the sheet the

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ability to absorb inks and give it good mechanical strength so it is not easily damaged as taught by Mukoyoshi et al and to form a paperboard material into containers where the paperboard does not lose any of its integrity, thereby allowing the container to hold hot and cold items longer as taught by Sandstrom et al.

Regarding the limitation of the a molded paper vessel formed by drawing in claim 15, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation of drawing is a method of production and therefore does not determine the patentability of the product itself. Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

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Response to Arguments

12. Applicant's arguments with respect to claims 1 – 16 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (703) 306-5480. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (703) 308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Patricia L. Nordmeyer
Examiner
Art Unit 1772

pln
pln
May 8, 2003


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

5/12/03